

In the Office Action, the Examiner has rejected claims 15, 16, 20 and 21 under 35 U.S.C. § 112 as containing new subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed had possession of the claimed invention. Specifically, the Examiner cites to the element, "the lower portion is coupled with said side wall" which he contends is not supported by the original specification. The Examiner has not commented on the substantive rejections previously addressed in the Amendment filed on April 30, 2002, in view of the new matter rejection.

Applicant respectfully disagrees with the Examiner's contentions and submits the following remarks in response.

The present invention as claimed in claim 15 is directed to a cap assembly comprised of a container having a plurality of sides and an opening disposed on a top portion of the container. The opening is disposed at the top of a first one of the plurality of side walls, where the opening is covered by a cap positionable in an opened and closed position. An extendable straw is provided having upper and lower portions. The lower portion is coupled with the first side wall, and the upper portion is coupled with an inner side of the cap so that when the cap is in an opened position, the straw is available at the opening for use.

The present invention further claims in claim 16 that the straw further comprising pleats disposed between the upper portion of the straw located on the cap and the second lower portion disposed along the first side wall so that the straw can bend over a base of the scored finger portion.

The present invention further claims in claim 20 that the cap is a scored finger portion and in claim 21 it is further claimed that a top opening of the straw is disposed co-planar with a top side of the scored finger portion.

In an amendment filed on April 30, 2002, received on May 8, 2002 claim 15 was amended to include the limitations, “said opening disposed at the top of a first one of said plurality of side walls” and “said straw having upper and lower portions, where said lower portion is coupled with said first side wall, and wherein said upper portion is coupled with an inner side of said cap”. Applicant respectfully submits that the additional elements added to the claims in April 30, 2002 amendment do not constitute new matter.

The relevant portions of the application that support the elements of the claims is found in Figs. 9a and 9b as well as lines 19-23 of page 10 of the specification.

Regarding claim 15, the element of the opening being disposed at the top of a first one of said plurality of side walls is self-evident from Figures 9a and 9b which clearly depict an opening disposed at the top of a first one of a plurality of sides.

The element of the upper portion (of the straw) being coupled with an inner the of said cap is supported not only by Figs. 9a and 9b, but it is also clearly indicated in lines 21 and 22 of page 10 of the specification. The relevant excerpt reads, “Instead, carton 70 has a scored finger 60 that can be pulled open to expose straw 62 that is attached to the underside of finger 60.” As such, the attachment of the upper portion of the straw to the finger portion is specifically indicated in the text of the application. This attachment is also illustrated in Fig. 9a where the upper portion of the straw is shown in a dashed outline to denote that it is attached to the underside of the cap. The straw is illustrated with dashed drawn in parallel to the lines

indicating the scored finger portion, further denoting its attachment to the underside of the cap.

Furthermore, when illustrated in the open position in Fig. 9b, the upper portion of the straw is clearly shown to be attached to the inner side of the scored finger portion.

Regarding the lower portion (of the straw) being coupled with the first side wall, this element is also supported by the specification as filed. It is noted that the drawings in Figs. 9a and 9b clearly illustrate this arrangement. The Court of Appeals for the Federal Circuit has recognized that, “drawings alone may provide a ‘written description’ of an invention as required by §112.” *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1565, 19 USPQ 2d 1111, 1117 (Fed. Cir. 1991); *See also In re Heinle*, 145 USPQ 131 (CCPA 1965) (Where the court stated that it is proper to include matter that is clearly and conclusively disclosed by the drawings. Were the drawings appear to conform to the one-fourth circumference limitation, it is possible to amend the application to include the one-fourth limitation without violating the rule against “new matter”.)

Both Figs. 9a and 9b illustrate the lower portion of the straw being attached to the side of the carton. In fact, consistent use of the dashed line to show connectivity of the straw to the finger portion and the side wall of the carton is used for both the upper and lower portions of the straw. As discussed above, the upper portion of the straw (portion above the pleated section), which is illustrated as attached to the cap by use of a dashed outline, is clearly defined in the language of the specification as connected to the inner side of the cap. The continued use of the dashed line to indicate that the location of the lower portion of the straw (portion below the pleated section) is also coupled to the wall of the carton is consistent through out both figures 9a and 9b. Further confirming this matter, if the bottom portion of the straw were not coupled,

there would be no need to use the pleat to separate the upper and lower portions of the straw.

Furthermore, similar to the upper portion of the straw, the lower portion of the straw is illustrated with dashed lines drawn in parallel to the lines indicating the lower wall of the carton denoting that the straw does not form an angle with the wall. If it were not, it would float freely in the bottom of the container similar to the straw illustrated in Figs. 8a and 8b, forming an angle with the wall.

Claim 16, where the pleated separation between the upper and lower portions of the straw is clearly supported in the application as filed. Figs. 9a and 9b both show the pleated intersection between the upper and lower portions of the straw. Element 64 specifically identifies the pleats. Lines 22 and 23 of page 10 of the specification reads, "Straw 60 has pleats 64 that allow it to bend without impeding the flow of liquid."

Claim 20, where the cap is claimed as scored finger portion is clearly supported in the application as filed. Figs 9a and 9b both show the scored finger portion cap. In fact, element 60 shown in both figures, specifically identifies the scored finger portion. Lines 21 and 22 of page 10 of the specification reads, "Instead, carton 70 has a scored finger 60 that can be pulled open to expose straw 62 that is attached to the underside of finger 60."

Claim 21, where the top of the straw is claimed to be coplanar with the top side of the scored finger portion, is clearly supported in the application as filed. Fig 9b shows the top of straw 62 to be co-planar with the top side of the scored finger portion 60.

As such, in view of the above remarks, Applicant submits that the subject matter of claims 15, 16, 20 and 21, entered in the Amendment filed April 30, 2002, does not constitute new matter. Applicant respectfully requests that the rejection of these claims under 35 U.S.C. §

112 be withdrawn, and that the substantive comments entered in response to the Examiner's 35 U.S.C. § 102 rejection from the October 31, 2001 amendment be addressed on their merits.

In view of the aforementioned amendment and remarks, it is respectfully submitted that all claims currently pending in the above identified application are now in condition for allowance, the earliest possible notice of which is earnestly solicited. If in the Examiner's opinion the prosecution of the present application would be advanced by a telephone interview, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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